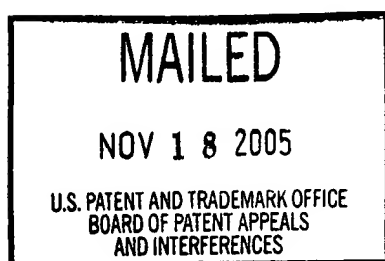


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GERALD DORROS, JUAN CARLOS PARODI, CLADIO JAVIER SCHONHOLZ
and MICHAEL HOGENDIJK



Appeal No. 2005-1527
Application No. 09/972,225

ON BRIEF

Before NASE, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5, 7 to 9, and 26 to 29. Claims 6, 10 to 25 and 30 have been withdrawn from consideration as being directed to a non-elected species.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of controlling cerebral blood flow (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

THE PRIOR ART REFERENCES

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|----------------------------------|-----------|--|
| Barbut et al. (Barbut '370) | 6,146,370 | Nov. 14, 2000 |
| Barbut et al. (Barbut '057) | 6,555,057 | Apr. 29, 2003 (Filed Jan. 14, 2000) |
| Zadno-Azizi et al. (Zadno-Azizi) | 6,022,336 | Feb. 8, 2000 |

THE REJECTIONS

Claims 1, 2, 5, 7 to 9, 26, 27, and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barbut '057 in view of Barbut '370.

Claims 3, 4 and 28 stand rejected under 35 U.S.C. §103 as being unpatentable over Barbut '057, Barbut '370 and further in view of Zadno-Azizi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer

(mailed August 11, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed April 19, 2004) and reply brief (filed December 28, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1, 2, 5, 7 to 9, 26, 27 and 29 under 35 U.S.C. § 103 as being unpatentable over Barbut '057 in view of Barbut '370. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner finds that Barbut '057 describes the invention as claimed except Barbut '057 does not describe that the occlusive element is configured for transluminal retrograde insertion via the descending aorta.¹ The examiner relies on Barbut '370 for

¹ We note that the examiner has not explained why the occlusive element of Barbut '057 is not configured for transluminal retrograde insertion via the descending aorta and it is not immediately apparent to us why it is not so configured.

teaching an occlusive element that can be introduced through the femoral artery and the descending aorta and concludes:

. . . [I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Barbut's ('057) catheter 12 with a catheter such as that used in Barbut's ('370) so that the catheter would be capable of insertion through the descending aorta to manipulate the cerebral blood flow [answer at pages 3 and 4].

Appellants argue that there is no motivation to combine the teachings of Barbut '057 with the teaching of Barbut '370.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d

1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

We find that Barbut '057 describes an apparatus for profusing the cerebral vasculature of a patient with oxygenated blood or other oxygenated media (col. 1, lines 16 to 20). As depicted in figure 6D the apparatus includes a catheter 12 having an inflatable occlusive element on the distal end thereof (Fig. 6D; col. 13, lines 9 to 11). The catheter 12 is configured for insertion via the jugular vein or the common carotid artery in the patient's neck (col. 12, lines 54 to 57). A flow control device 100 or 104 is provided which is configured for insertion separately from the catheter via the brachiocephalic artery and subclavian artery respectively (col 16, lines 37 to 55). Oxygenated blood or other media flows through catheter 12 and flow control devices 100 and 104 (col. 16, lines 25 to 58).

Barbut '370 describes a device to reverse flow of blood down an internal carotid artery and up the ipsilateral external carotid artery during an invasive carotid procedure to thereby avoid distal embolization of vascular debris (col. 2, lines 23 to 32). Barbut '370 describes a catheter with a balloon occluder disposed on the distal end thereof

and a lumen 5 adapted for introduction of therapeutic or diagnostic instruments (col. 5, lines 44 to 50). The device may be inserted through the femoral artery.

We agree with the appellants that there is no motivation to combine the teachings of Barbut '057 with the teachings of Barbut '370. Barbut '057 is a device to provide oxygenated blood or other media to the cerebral vasculature through the neck of the patient. Although, Barbut '370 does describe a catheter that is inserted through the femoral artery and may be thereby passed into the descending aorta, there is no motivation for a person of ordinary skill in the art to modify the Barbut '057 device so that the catheter is inserted through the femoral artery. The teaching of Barbut '370 is directed to a device for preventing distal embolization from the carotid artery whereas Barbut '057 is directed to providing oxygenated blood of media to the cerebral vasculature. The examiner has not explained why a person of ordinary skill in the art would have been motivated to insert the Barbut '057 catheter via the femoral artery and thus modify it so as to be configured for such insertion.

In view of the foregoing, we will not sustain this rejection.

We will likewise not sustain the examiner's rejection of claims 3, 4 and 28 under 35 U.S.C. § 103 as being unpatentable over Barbut '057, Barbut '370 as applied in the first rejection and further in view of Zadno-Aziz because this rejection relies on the combination of Barbut '057 and Barbut '370.

REVERSED

JEFFREY V. NASE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
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